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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,523	09/15/2000	Veronique Roulier	6388-0518-0	9437

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/17/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/555,523

Applicant(s)

ROULIER ET AL.

Examiner

Alysia Berman

Art Unit

1617

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12, 13, 15-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 15-29 and 34-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2002 has been entered.

Claims 39-46 have been added. No claims have been amended. Claims 1-10, 12, 13, 15-32 and 34-46 are pending.

### ***Election/Restrictions***

Claims 12, 13 and 30-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-29, 34-38 and 43-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

Art Unit: 1617

inventor(s), at the time the application was filed, had possession of the claimed invention. The specification explicitly excludes surfactants from the inventive composition. Further, none of the examples in the specification contain a surfactant. The specification does not provide a written description of a composition that contains a surfactant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10, 15-29 and 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09255529 A (JP '529) in combination with US 5,326,484 (484). See the translation of JP '529 for citation purposes.

Art Unit: 1617

JP '529 is directed to oil-in-water emulsions that do not contain a surfactant with an average particle size of the oily phase less than 1 micron (page 3). Copolymers Pemulen® TR-1 or Pemulen® TR-2, which are Applicant's preferred alkyl acrylate/methacrylate copolymers, are disclosed in claim 3 at page 4. The amount of copolymer in the emulsion is from 0.01-10 wt.% and the amount of oily phase is from 0.5-20 wt.% (claim 4 at page 4). For compositions in the form of milks and creams see page 9, section [0002] and page 18, section [0026]. For silicone oils that can be part of the oily phase of the compositions see page 22, section [0036].

JP '529 does not teach that the oily globules are monodispersed (claims 1 and 20), the amount of monomers in the copolymer (claims 2 and 21), the formula of the monomers in the copolymer (claims 3 and 22), the viscosity of the copolymer (claims 15, 16, 31, 32, 34 and 35) or that the silicone oils are volatile (claims 39-41 and 43-45).

US '484 is directed to monodispersed emulsions (title and abstract). US '484 teaches that non-monodispersed emulsions exhibit poor stability and require large amounts of surfactants to improve the stability (col. 1, lines 27-34). The emulsions of US '484 overcome these disadvantages. US '484 teaches at column 9, lines 29-35 that the emulsions can be used in cosmetics.

Applicant discloses at page 5, lines 14-22, that Pemulen® TR1 and Pemulen® TR2 exhibit the instantly claimed viscosities. Because these are disclosed as preferred copolymers of Applicant, it is presumed that these polymers meet the limitations of the weight percent ranges of monomers and monomer formulas as instantly claimed.

Art Unit: 1617

Burden is shifted to Applicant to show that the copolymers of the prior art do not exhibit these properties or characteristics.

Applicant does not provide any guidance either in the specification or the claims as to the degree of volatility required by the instantly claimed oils. The silicone oils disclosed by JP '529 exhibit vapor pressures and, therefore, are volatile. Thus, the disclosure of silicone oils in JP '529 reads on the instantly claimed volatile silicone oils. The phrase, "consists essentially of" limits the scope of the claims to the specified ingredients and those that do not materially affect the basic and novel characteristics of a composition *Ex parte Davie*, supra; *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963). The prior art achieves the same result as Applicant, a stable emulsion. Therefore, absent a showing by Applicant that the basic and novel characteristics of the composition are materially affected, JP '529 encompasses claims 39-41 and 43-45.

It would have been obvious to one of ordinary skill in the art at the time of the invention to monodisperse the emulsion of JP '529 as taught by US '484 expecting to obtain a stable emulsion without the use of surfactants.

### ***Response to Arguments***

Applicant's arguments filed October 3, 2002 have been fully considered but they are not persuasive.

Applicant argues that the specification provides support for compositions that do not exclude surfactants at page 1, lines 1-7. This is not found persuasive because Applicant explicitly excludes surfactants from the instant invention at page 2, lines 8-27.

Art Unit: 1617

None of the examples provided by Applicant contains a surfactant. Applicant does not disclose surfactants as one of the common additives that may be contained in the instant emulsion. It is clear from Applicant's disclosure that Applicant's intent is to exclude surfactants from the emulsions. Therefore, it does not appear that Applicant had possession of the instantly claimed invention at the time the application was filed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to use the method of US '484 to make the emulsion of JP '529 is to obtain a stable emulsion without the use of surfactants.

US '484 is not limited to any specific oils by its examples and, in fact, provides a general teaching of making monodispersed emulsions for use in cosmetics. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972). Disclosure of a composition of matter in a reference may be anticipatory even though the reference indicates that the composition is not preferred or even that it is unsatisfactory for the intended purpose. See *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Based on the disclosure of US '484, one of

Art Unit: 1617

ordinary skill in the art would have a reasonable expectation of success in making a monodispersed emulsion of JP '529.

Applicant argues that instant claims 39-41 and 43-45 require different oils from JP '529. As discussed in the 35 U.S.C. 103(a) rejection above, JP '529 discloses non-solid oils that are encompassed by the instant claims for use in the compositions.

Applicant argues that claims 42 and 46 are directed to non-solid, easily spreadable compositions (milks and creams) that are different from the solid compositions of JP '529. JP '529 does not limit its composition to the solid. In fact, the Examiner could find no disclosure in the four corners of JP '529 stating that the composition was a solid. JP '529 does disclose that the composition can be in a non-solid form as discussed in the 35 U.S.C. 103(a) rejection above.

### ***Correspondence***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.



Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysja Berman  
Patent Examiner  
January 15, 2003

  
RUSSELL TRAVERS  
PRIMARY EXAMINER  
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